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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,155

11/17/2003

Makiko Kobayashi

1046.1303

9446

21171 7590 02/01/2007
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EXAMINER

TANK, ANDREW L

ART UNIT

PAPER NUMBER

2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/713,155

Applicant(s)

KOBAYASHI ET AL.

Examiner

Andrew Tank

Art Unit

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the preliminary amendment filed on November 17, 2003.

Claims 1-37 are pending and have been considered below.

2. Examiner's Note. The Applicant appears to be attempting to invoke 35 U.S.C. 112 6th paragraph in Claim 5 by using "means-plus-function" language. However, the Examiner notes that the only "means" for performing these cited functions in the specification appears to be computer program modules. While the claims pass the first test of the three-prong test used to determine invocation of paragraph 6, since no other specific structural limitations are disclosed in the specification, the claims do not meet the other tests of the three-prong test. Therefore, 35 U.S.C. 112 6th paragraph has not been invoked when considering these claims below.

3. The amendment to the claims filed on November 17, 2003 does not comply with the requirements of 37 CFR 1.121(c) because the listing of claims was not started on a separate sheet. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing*. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not

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entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

Specification

4. The disclosure is objected to because of the following informalities: several grammatical errors such as page 1 [0002] lines 1-2, page 1 [0003] lines 2-4, page 1[0003] lines 5-9 etc. These errors are seemingly due to poor English translation. Also, the title on page 8 “DESCRIPTION OF DRAWINGS” should read “BRIEF DESCRPTION OF DRAWINGS”. Appropriate correction is required.

Claim Objections

5. Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 23 claims dependence on itself. For the sake of the current prosecution, the examiner will interpret claim 23 as being dependent on claim 22.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 29-37 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. A program is not a process, machine, manufacture, or composition of matter, nor any of the judicial exceptions to 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1-7, 20-26, and 29-35 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent Application 2002/0070973 (Croley).

Claims 1, 20 and 29: Croley discloses an information display method comprising the steps of:

- i. causing a display device to display a screen containing a data input box for data specified by data identifying information in accordance with definition information on the screen (page 2 [0027]);
- ii. storing the data inputted to the data input box together with the data identifying information (page 2 [0029]);
- iii. searching for the data corresponding to the data identifying information from the storage unit when having the screen displayed (page 2 [0030]); and
- iv. setting the searched data into the data input box specified by the data identifying information (page 3 [0034]).

Claims 2, 21 and 30: Croley discloses an information display method according to claims 1, 20, and 29 above, further comprising:

- i. receiving the definition information, wherein the definition information contains the data identifying information, and in the searching step the data is searched for by the data identifying information contained in the definition information received (page 2 [0029] and page 3 [0030]).

Claims 3, 22 and 31: Croley discloses an information display method according to claims 1, 20, and 29 above, wherein, in the storing step, plural pieces of data inputted to the data input box in the past are stored (page 2 [0029]), and in the setting step one piece of data

among the plural pieces of data is set into the data input box (page 3 [0030]), and the remaining data are displayed as options in the vicinity of the input box (page 3 [0030], page 3 [0033]).

Claims 4, 23 and 32: **Croley** discloses an information display method according to claims 3, 22 and 31 above, further comprising determining a priority order of the data set into the data input box (page 2 [0027] “alpha-type entries”, page 2 [0029] “designated key default fields”).

Claims 5, 24, and 33: **Croley** discloses an information display method according to claims 3, 22, 23, and 31 above, further comprising a step of determining a data arrangement order of the data displayed as the options (page 2-3 [0030]).

Claims 6, 25, and 34: **Croley** discloses an information display method according to claims 1, 20, and 29 above, further comprising obtaining information for identifying a user, wherein in the storing step the data is stored in a way that relates the data to the information for identifying the user, and in the searching step the data corresponding to the data identifying information for every user is searched for (page 3 [0034-0038] historical data as related to doctors and patients).

Claims 7, 26, and 35: **Croley** discloses an information display method according to claims 1, 20, and 29 wherein, in the storing step, plural pieces of data identifying information related to the data are stored (page 2 [0029]), and in the searching step the data is searched for by any one piece of data identifying information among the plural pieces of data identifying information (page 2 [0028]).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-19, 27-28, and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application 2002/0070973 (**Croley**).

Claims 8, 14, 27-28, and 36-37: **Croley** discloses an communication method involving the steps of:

- i. storing the data inputted to the data input box together with the data identifying information (page 2 [0029]);
- ii. searching for the data corresponding to the data identifying information from the storage unit when having the screen displayed (page 2 [0030]); and
- iii. setting the searched data into the data input box specified by the data identifying information (page 3 [0034]).
- iv. However, **Croley** does not specifically disclose that communication method involves communicating between a server computer and a terminal computer on a network. **Croley** does disclose that the display is on a computer screen (page 2 [0013-0014]), implying that **Croley's** method is acted on a computer. Also, **Croley** discloses that the output can be placed in an email format (page 3 [0039]), which implies that the computers can be networked together. Therefore, it would have been obvious to one of ordinary skill in the art at the

time the present invention was made to use the communication method for relaying data between a server computer and a terminal computer on a network.

One would have been motivated to do this in order to provide one or more users spread across a plurality of terminals access to remote servers containing databases. This increases the accessibility and usability to the user, as well as providing redundancy to the data contained in the databases.

Claims 9 and 15: **Croley** discloses the devices as in claims 8 and 14 above, and further discloses that the storage unit is stored with plural pieces of data inputted to the data input box in the past (page 2 [0029]), and the control unit sets one piece of data among the plural pieces of data into said data input box (page 3[0030]) and adds to the definition information a piece of information for having the remaining data displayed as options in the vicinity of the input box (page 3 [0030] and [0033]).

Claims 10 and 16: **Croley** discloses the devices as in claims 9 and 15 above, and further comprising a determining unit determining a priority order of the data set into the data input box (page 2 [0027] “alpha-type entries”, page 2 [0029] “designated key default fields”).

Claims 11 and 17: **Croley** discloses the devices as in claims 9, 14 and 16 above, and further comprising an arrangement unit determining a data arrangement order of the data displayed as the options (page 2-3 [0030]).

Claims 12 and 18: **Croley** discloses the devices as in claims 9 and 15 above, and further comprising an obtaining unit obtaining information for identifying a user of the terminal, wherein the storage unit is stored with the data in a way that relates the data to the

information for identifying the user, and the control unit searches for the data corresponding to the data identifying information for every user (page 3 [0034-0038] historical data as related to doctors and patients).

Claims 13 and 19: Croley discloses the devices as in claims 9 and 15 above, wherein the storage unit is stored with plural pieces of data identifying information related to the data (page 2 [0029]), and the control unit searches for the data by any one piece of data identifying information among the plural pieces of data identifying information (page 2 [0028]).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. U.S. Patent 5,845,300 Corner et al. "Method and apparatus for suggesting completions for a partially entered data item based on previously-entered, associated data items"
 - b. U.S. Patent 6,208,339 Atlas et al. "User-interactive data entry display system with entry fields having distinctive and changeable autocomplete"
 - c. U.S. Patent 6,377,965 Hachamovitch et al. "Automatic word completion system for partially entered data"
 - d. U.S. Patent 6,829,607 Tafoya et al. "System and method for facilitating user input by automatically providing dynamically generated completion information"

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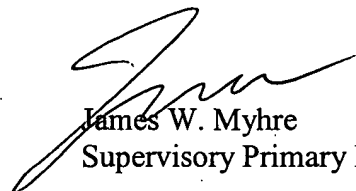
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Tank whose telephone number is 571-270-1692. The examiner can normally be reached on Mon - Fri (Alt. Fri Off) 0730-1500 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



ALT
January 29, 2007



James W. Myhre
Supervisory Primary Examiner